



UNITED STATES PATENT AND TRADEMARK OFFICE

nlw

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,078	10/06/2000	David Allison Bennett	PSTM0010/MRK/STM	3150

29524 7590 03/23/2004

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,078

Applicant(s)

BENNETT ET AL.

Examiner

Jamisue A. Webb

Art Unit

3629

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6.7.11</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The declarations filed with the Information Disclosure Statement #6, filed 8/22/01, are not considered to be proper IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

Specification

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

3. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.75(f) which requires all claims to be numbered sequentially. In the present case, Claim 32 is missing and therefore claims 33-58 have been renumbered to claims 32-57. The examiner suggests the applicant amend the dependency of all dependent claims of claims 32-57 to reflect the renumbering of claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3629

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 4-8, 10, 13-17, 19, 22-26, 28, 31-35, 38-42, 45-50, 52, 54, 55, and 57 recite the limitations "each user client computer device" and "the particular user client computer device". There is insufficient antecedent basis for these limitations in the claims. The claims have previously recited a client computer device, but have not claimed a user client computer device, therefore it is unclear if they are one in the same.

8. With respect to Claims 1, 7, 10, 16, 19, 25, 28, 34, 35, 41, 42, 48-50, 52, 54, 55 and 57: the phrase "each of a plurality of users" is indefinite. It is unclear as to each what, of a plurality of users. Is this "each user of a plurality of users"? It is unclear to the examiner what the word "each" is referring to, therefore it is unclear who is receiving the display.

9. With respect to Claims 1, 8, 10, 17, 19, 26, 28, 35, 42, 49, 52 and 55: the phrase "an identification of each of a plurality of carriers" is indefinite. It is unclear as to each what, of a plurality of carriers. Is this "each carrier of a plurality of carriers"? It is unclear to the examiner what the word "each" is referring to, therefore it is unclear what or who the identification is for.

10. With respect to Claims 4, 8, 13, 17, 22, 26, 31, 38 and 45: the phrase "calculate for each of a plurality of services" is indefinite. It is unclear as to each what, of a plurality of services. Is this "each service of a plurality of services"? It is unclear to the examiner what the word "each" is referring to, therefore it is unclear what is exactly being calculated.

Art Unit: 3629

11. With respect to Claims 2-6, 8, 9, 11-15, 17, 18, 20-24, 26, 27, 29-33, 36-40, and 43-47: the claims are written in long run-on sentences, which cause them to be unclear and very difficult to read. The examiner suggests the use of commas, to separate what is actually being generated or identified or calculate, from the descriptive phrases of the claim. For example: In Claim 2, the phrase "recognize as a user request for an electronic mail delivery notification service for a particular parcel that is to be shipped a user input..." is indefinite. It is unclear what is actually being recognized, is it a user request or a user input that is being recognized? Therefore, the examiner would suggest putting a comma between the words "recognize as" and also put a comma between the words "shipped a"

12. Claims 7, 16, 25, 34, 41, 48, 50, 54 and 57 recite the limitation "the particular user". There is insufficient antecedent basis for this limitation in the claims.

13. With respect to Claims 31 and 32 (previously recited as claim 33): These Claims are dependent on Claim 32, which is nonexistent, therefore it is unclear what these claims are fully claiming.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-18, 28-41, and 49-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

16. The basis of this rejection is set forth in a two-prong test of:

Art Unit: 3629

- a. whether the invention is within the technological arts; and
- b. whether the invention produces a useful, concrete, and tangible result.

17. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e. the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts. In the present case, Claims 1-18, 28-41, and 49-54 only recite an abstract idea. The recited steps of merely identifying carriers that provide a delivery confirmation and calculating rates does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. Even though the claim recites the user accessing a computer system, these steps only constitute an idea of how to apply these rules to choose one carrier over another, they do not require the use of the computer system to do them.

18. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps require anything in the technological arts, as explained above. Looking at the claim as a whole, nothing in the body of

Art Unit: 3629

the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore the preamble is taken to merely recite a field of use.

19. Additionally for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces calculated rates for carriers used in selecting a specific service for shipping (i.e., useful and tangible).

20. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 1-18, 28-41, and 49-54 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 3629

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

23. Claims 1-27, and 49-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Fisher et al. (6,047,264) and Kara et al. (6,233,568).

24. With respect to Claims 1, 4, 6-10, 13, 15-19, 22, 24-27, 49-50, 52, 54, 55, and 57: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the proof of delivery is an electronic mail delivery notification. Fisher discloses a method for supplying automatic status updates using e-mail (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher, in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative. See Fisher, columns 1 and 2).

Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

25. With respect to Claims 2, 11, 20, 29, 36 and 43: See Nicholls, Figure 4A.

26. With respect to Claims 3, 12, 21, 30, 37, and 44: See Nicholls, Column 7, lines 53-67.

27. With respect to Claims 5, 14, 23, 32, 39 and 46: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

28. Claims 28-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Pauley et al. (4,958,280) and Kara et al. (6,233,568).

29. With respect to Claims 28, 31, 33-35, 38, 40-42, 45, 47, 48: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of

Art Unit: 3629

the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal delivery notification. Pauley discloses the use of costumer service representatives which provide verbal communication of delivery status (Column 9, lines 34-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley, in order to allow users to obtain delivery information without the use of a computer. See Pauley columns 2 and 4).

Nicholls and Pauley disclose a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

30. With respect to Claims 29, 36 and 43: See Nicholls, Figure 4A.

31. With respect to Claims 30, 37, and 44: See Nicholls, Column 7, lines 53-67.

Art Unit: 3629

32. With respect to Claims 32, 39 and 46: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

Conclusion


33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vaghi (6,047,273) discloses the use of a method of shipping where multiple shipping rates are given for multiple carriers, Thiel (6,035,291) discloses the use of an automatic selection of carrier from a plurality of carriers Boucher (6,078,889) discloses the use of a carrier library, Piccione (4,495,581) discloses the use of a postal rate calculator with multiple carrier selection, Danford-Klien et al. (6,047,271) discloses a computer rating system for multiple carriers, Hisbani et al (EP 0943904) discloses calculated rates being based on the class of service provided for shipping, and ABF freight systems (www.abfs.com) discloses a press release of a program that calculates shipping rates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamisue Webb

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600